



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,751	02/14/2001	Michael R. Miller	QOD1P008/03634/02241	2170

7590 02/22/2005

Mr William Fritz
NeoMedia Technologies, Inc.
2201 Second Street
Suite 600
Fort Myers, FL 33901

EXAMINER

PEREZ DAPLE, AARON C

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/783,751	MILLER ET AL.	
	Examiner	Art Unit	
	Aaron C Perez-Daple	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to Application filed 2/14/01.
2. Claims 1-20 are presented for examination.
3. This Action is non-Final.

Priority

4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Specifically, priority application 09/296,479 does not disclose the steps of searching for vendors of the products on a list nor selecting a vendor. Because these steps are recited in independent claims 1, 8 and 15 of the present application, claims 1-20 are not entitled to the benefit of application 09/296,479.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2154

6. **Claims 15-20** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the claims are directed towards “logic,” which the Examiner reasonably interprets may consist of software. Software *per se* in non-statutory when it is not tangibly embodied. See MPEP 2106 IV.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 7 and 14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, step (a) of claims 1 and 8 recite receiving *a plurality* of product identifiers from a user. It is not clear to the Examiner how this step can be repeated each time *a single* product identifier is received from a user, as required by claims 7 and 14. For the purpose of applying prior art, the Examiner interprets that adding products to an order by receiving a product identifier is sufficient to anticipate the claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2154

10. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being obvious over Walker et al.

(US 6,754,636 B1) (hereinafter Walker) in view of Green et al. (US 5,664,110) (hereinafter Green).

11. As for claims 1, 7, 8, 14 and 15, Walker teaches a method, computer program product, and logic for selecting a vendor based on a list of user-selected products, comprising the steps of:

(a) receiving a plurality of product identifiers from a user, wherein each product identifier is associated with a particular product (col. 5, lines 15-45);

(c) searching for vendors of the products (col. 7, lines 62-63);

(d) selecting a vendor of the products based on predetermined criteria (col. 7, line 62 – col. 8, line 3); and

(e) outputting information about the selected vendor (col. 8, lines 51-65).

Walker does not specifically teach *generating a list* of products. However, Green teaches a remote purchasing system similar to that of Walker which further comprises generating a list of products by adding products associated with product identifiers to a list (col. 1, lines 38-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walker by generating a list of products in order to improve customer convenience by ordering multiple products at once, as taught by Green (col. 1, lines 38-47).

12. As for claims 2, 9 and 16, although Walker teaches the use of bar codes for identifying a product (col. 6, lines 42-52), Walker does not specifically teach receiving a bar code from a user prior to selecting a vendor. Green teaches receiving a bar code from a user in order to conveniently select products for order (col. 1, lines 51-54; col. 3, lines 5-21). It would have

been obvious to one of ordinary skill in the art at the time of invention to modify Walker by receiving a bar code from a user prior to selecting a vendor in order to conveniently select the products for order, as taught by Green above.

13. As for claims 3, 10 and 17, Walker teaches a method as recited in claim 1, wherein the vendor is selected based on the number of products on the list available from the vendor (col. 7, line 62 – col. 8, line 3).

14. As for claims 4, 11 and 18, Walker teaches a method as recited in claim 1, wherein the criteria for selecting the vendor include at least one of price, proximity to the vendor, availability of delivery, whether the products are in stock, wrapping availability, shipping availability, tracking availability, and a loyalty program (col. 7, line 62 – col. 8, line 3).

15. As for claims 5, 12 and 19, Walker teaches a method as recited in claim 1, further comprising the steps of determining an availability of the products at each of a plurality of vendors, determining costs of the products charged by each of the vendors, and outputting summaries of the determinations (col. 7, line 32 – col. 8, line 3; Figs. 12A and 15).

16. As for claims 6, 13 and 20, Walker teaches a method as recited in claim 1, wherein a promotional offer is output with the information about the selected vendor (col. 8, line 66 – col. 9, line 3).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5,734,823, note abstract;

Art Unit: 2154

US 6,434,530 B1, note interactive shopping system with barcode reader;

US 6,249,772 B1, note cols. 4-5 and Fig. 8A;

US 6,308,893 B1, note abstract;

US 5,903,875, note use of tickets for exchange for merchandise;

US 5,761,648, note teaches dispensing ticket;

US 5,612,868, note Fig. 1;

US 5,418,354, note abstract;

US 5,250,789, note abstract.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron C Perez-Daple whose telephone number is (571) 272-3974. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

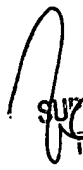
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/783,751

Page 7

Art Unit: 2154

 2/7/05
Aaron Perez-Daple

 JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100